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10/714,328

11/14/2003

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EXAMINER

ELVE, MARIA ALEXANDRA

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRYAN PRUCHER

Appeal 2008-0448
Application 10/714,328
Technology Center 1700

Decided: January 24, 2008

Before CHUNG K. PAK, LINDA M. GAUDETTE, and MICHAEL P.
COLAIANNI, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

1 This is an appeal from the final rejection of claims 1-3, 5-11, 13,
and 16-21, the only claims pending in the application. We have jurisdiction
under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates to a method of manufacturing dispersion strengthened copper and/or hyper-nucleated metal matrix composite resistance welding electrodes directly from a sintered powdered metal compact pre-form. (Spec. [0002]). The inventive process is said to be advantageous over conventional processes in that it does not require the typical process steps of packing and sealing the powder into a copper billet can and then hot extruding the billet in an extrusion press to form HNMMC and/or DSC rod. (Spec. [0037]). In addition, the process of the invention does not require a secondary machining operation on the finished electrode to remove the pure copper cladding. (Spec. [0037]). Claim 1 is illustrative of the invention and is reproduced below:

1. A process of manufacturing a resistance welding electrode, comprising the steps of:
 - compacting a powdered metal material into a desired pre-form densified compact shape,
 - sintering the compact shape in an inert atmosphere, and
 - shaping the resultant sintered powdered metal compact shape into its final net shaped electrode form by either cold forming or semi-solid molding.

The Examiner relies on the following prior art references to show unpatentability:

Nadkarni	4,315,777	Feb. 16 1982
Shimamura	5,004,498	Apr. 4, 1991
Prucher	5,041,711	Aug. 20, 1991
Kato	5,685,357	Nov. 11, 1997

The Examiner made the following rejections¹:

¹ The Answer neither repeats nor expressly withdraws the rejection of claim 7 under 35 U.S.C. §112, second paragraph. We treat this rejection as having

1. Claims 1-3 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Shimamura.
2. Claims 8-11, 13, and 17 under 35 U.S.C. § 103 as unpatentable over Shimamura in view of Nadkami.
3. Claims 16² and 19-20 under 35 U.S.C. § 103 as unpatentable over Shimamura and Nadkami and further in view of Kato.
4. Claim 18 under 35 U.S.C. § 103 as unpatentable over Shimamura and Nadkami and further in view of Prucher.
5. Claim 21 under 35 U.S.C. § 103 as unpatentable over Shimamura Nadkami, Kato and Prucher.

We affirm as to all grounds of rejection for essentially those reasons expressed in the Answer. We include the following discussion for the sake of completeness.

Section 102(b) Rejection

Appellant does not refute the Examiner's finding that Shimamura discloses forming a dispersion strengthened copper alloy by the claimed steps of compacting and sintering. Appellant contends that Shimamura fails to anticipate the claims because Shimamura's method includes a step of machining or thermal treatment prior to a final cold forming (i.e., Shimamura's "plastic deformation") step. (Br. 7). Appellant maintains that the appealed claims do not require subsequent steps of machining or thermal treatment after a pre-form is made. (Br. 7). Appellant notes that in the

been withdrawn. *See Ex parte Emm*, 118 USPQ 180, 181 (Bd. App. 1957) (rejection not referred to in the examiner's answer is assumed to have been withdrawn).

² Claim 16 depends from canceled claim 15. Appellant should correct this error in the event of further prosecution,

inventive process, only a single step of cold forming or semi-solid molding is required to form a final net shaped finished electrode. (Br. 7).

The Examiner disagrees, arguing that Shimamura discloses that “the dispersion strengthened copper alloy may be subjected to plastic deformation and then subjected to a secondary process, which could be thermal, further plastic deformation and/or machining.” (Ans. 6-7 (quoting Shimamura, col. 10, lines 28-35)).

A reference is anticipatory within the meaning of § 102 if it discloses each and every claim limitation either expressly or inherently. Appellant has not presented arguments traversing the Examiner’s finding that Shimamura does, in fact, disclose the method steps *as claimed*. Nor has Appellant explained why the claims, as drafted, preclude Shimamura’s additional process step(s), e.g., “a secondary process.” *See In re Baxter*, 656 F.2d 679, 688 (CCPA 1981) (noting that the transitional term “comprising” indicates that the claimed process is left open to the inclusion of additional process steps which are not recited). Absent such arguments, we conclude that the Examiner properly established a prima facie showing of anticipation.

The decision of the Examiner rejecting claims 1-3 and 5-7 under 35 U.S.C. § 102(b) as anticipated by Shimamura is affirmed.

Section 103 Rejections

Appellant contends that the Examiner’s obviousness rejections are based on improper hindsight reasoning. (Ans. 8). Appellant has not, however, advanced any arguments with respect to the primary reference, Shimamura, beyond those raised in connection with the rejection under 35 U.S.C. § 102(b). Nor has Appellant refuted the Examiner’s findings with respect to the secondary references. Moreover, Appellant has not explained,

with any degree of specificity, why the Examiner's reasons for combining the references are improper.

We have considered the facts and reasons relied on by the Examiner in support of each of the rejections under 35 U.S.C. § 103, and find that they are sufficient to establish a prima facie showing of obviousness as to each of the separately rejected groups of claims: claims 8-11, 13, and 17; claims 16 and 19-20; claim 18; and claim 21. Because Appellant has not presented persuasive arguments or evidence to the contrary³, we conclude that a preponderance of the evidence weighs in favor of the Examiner's conclusion of obviousness.

Accordingly, we affirm the decision of the Examiner rejecting claims 8-11, 13, and 17 under 35 U.S.C. § 103 as unpatentable over Shimamura in view of Nadkami, claims 16 and 19-20 under 35 U.S.C. § 103 as unpatentable over Shimamura and Nadkami and further in view of Kato, claim 18 under 35 U.S.C. § 103 as unpatentable over Shimamura and Nadkami and further in view of Prucher, and claim 21 under 35 U.S.C. § 103 as unpatentable over Shimamura Nadkami, Kato and Prucher.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tc

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³ We refer to the Examiner's Response to Argument (Ans. 6-13) for a detailed analysis of Appellant's arguments and explanation as to why these arguments lack persuasive merit.

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